The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

Paper No. 29

## UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL E. MASSOD

Appeal No. 2004-0023 Application 09/334,574 MAILED

AUG 1 7 2004

PAT & T.M OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

ON BRIEF

Before JERRY SMITH, RUGGIERO, and MACDONALD, <u>Administrative</u>
<u>Patent Judges</u>.

RUGGIERO, Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-4, 6-16, and 18-36, which are all of the claims pending in the present application. Claims 5 and 17 have been canceled. An amendment filed September 23, 2002 after final rejection was denied entry by the Examiner.

The claimed invention relates to inventory management including the verification that articles, which have been physically grouped by a manual or automated grouping process into a physically grouped order, belong to the physically grouped order. The verification operation includes the scanning of unique identifier codes on tags associated with the articles to determine that the articles belong in the physically grouped order. A positive indication is provided to an operator if the scanned unique code does not correspond to an article that properly belongs in the physically grouped order.

Representative claim 1 is reproduced as follows:

1. A method of inventory management comprises:

verifying that articles, which were physically grouped by a manual or automated grouping process into a physically grouped order, belong to the physically grouped order:

examining codes on tags by scanning unique identifier codes on the tags, each tag associated with one article in the group to determine that the article belongs in the grouped order;

positively indicating to an operator if the scanned unique sequential code does not correspond to an item that belongs in the grouped order.

The Examiner relies on the following prior art:

Amacher et al. (Amacher) 4,716,281 Dec. 29, 1987 Markman 5,794,213 Aug. 11, 1998

Claims 1-4, 6-16, and 18-36, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Markman alone with respect to claims 1-4, 6-16, 18-27, and 34-36, and adds Amacher to Markman with respect to claims 28-33.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (Paper No. 26) and the Answer (Paper No. 27) for the respective details.

## **OPINION**

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1-4, 6-16, and 18-36. Accordingly, we affirm.

Appellant's arguments in response to the Examiner's rejection of the appealed claims are organized according to a suggested grouping of claims indicated at page 7 of the Brief.

We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered [see 37 CFR § 1.192(a)].

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 1, the representative claim for Appellant's first suggested grouping (including claims 1, 2, 11-14, 23, 24, 34-36) based on the Markman reference, Appellant contends that the Examiner has failed to establish a <u>prima facie</u> case of obviousness since all of the claim limitations are not taught or suggested by the applied prior art. We do not find Appellant's arguments to be persuasive for the reasons which we set forth infra.

Initially, we find no error in the Examiner's analysis (Answer, pages 3 and 7) which, in our view, correctly establishes correspondence between the claimed physical grouping of articles and that disclosure of Markham (column 5, lines 23-47; column 10, line 66 through column 11, line 13) which describes the physical grouping of articles as presented by a customer of a dry cleaning establishment. We do not necessarily disagree with Appellant's assertion (Brief, page 10) that, unlike the disclosed verification method which operates on grouped articles to verify a correct grouping, Markman's system operates on ungrouped articles to assemble them in the correct grouping. It is the <u>claimed</u> invention, however, which is before us on appeal. apparent to us that, from Markman's disclosure, the verification of the correctness of the group assembling operation at the output side of the dry cleaning process relates to a physical grouping performed at the customer input side. We find no claim language which precludes the physical grouping from taking place at the input side of the dry cleaning process.

Further, notwithstanding Appellant's arguments (Brief, pages 9 and 10) to the contrary, our own independent review of Markman reveals that the described operation of the signal light indicators 92 associated with the storage locations 84 provides a

positive indication to an operator that a scanned item does not belong to a particular grouped order. Upon our review of Appellant's specification, we fail to find any definition of the term "positive" that is different from the ordinary meaning. We note that the definition most suitable for "positive" as set forth in Webster's Ninth New Collegiate Dictionary is "... c: fully assured: CONFIDENT." It is apparent to us that, from the disclosure of Markman, when an operator performs a scanning operation while assembling items belonging to a customer's presented grouped order (as signified by the lighting of an indicator 92 above a first storage location associated with a particular grouped order), the lighting of an indicator 92 over a different location provides a positive indication to the operator that the scanned item does not belong in the first grouped order.

With the above discussion in mind, it is apparent to us that all of the elements recited in representative claim 1 are in fact present in the disclosure of Markman. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." <u>Jones v. Hardy</u>, 727 F.2d 1524, 1529,

<sup>&</sup>lt;sup>1</sup> A copy is enclosed along with this decision.

220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Accordingly, we sustain the Examiner's 35 U.S.C. § 103(a) rejection, based on Markman, of representative claim 1, as well as claims 2, 11-14, 23, 24, and 34-36 which Appellant has chosen to let stand or fall with claim 1, and claims 25 and 26 not separately argued by Appellant.

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection, based on Markman, of representative dependent claim 3, as well as claims 10, 15, 22 which fall with claim 3 in accordance with Appellant's grouping. Appellant's argument in response (Brief, page 11) to the Examiner's rejection of claim 3 directs attention to the illustration in Figure 3 of Markman and asserts that, in contrast to the claimed invention, the bar codes 50 do not provide unique sequential identification since each group receives the same bar code. We do not find this argument to be persuasive. While we don't necessarily agree with the Examiner's proffered interpretation (Answer, page 3) of the term "sequential," there is no language in appealed claim 3 that requires sequential identification in the form of bar codes, rather, the claim requires only sequential identification in

"machine readable format". In our view, the sequential numbers (1, 2, 3, 4) appearing on tags 34 in Figure 3 of Markman are clearly capable of being read by a machine, i.e., they are machine-readable as claimed. We would also point out that the step of "scanning," the only positively recited method step in claim 3, is not required to be performed by machine.

Turning to a consideration of the Examiner's 35 U.S.C.

§ 103(a) rejection, based on Markman, of representative claim 4
(and claims 6, 16, and 18 which fall with claim 4), and
representative claim 7 (and claims 8, 9, 19, and 21 which fall
with claim 7), we sustain this rejection as well. With the above
discussion of the feature of "unique sequential identification"
appearing in claim 3 in mind, it is our view that Markman's
examination of the sequential codes on the tags 32 to determine
whether articles are a part of a group (appealed claim 4) or
correspond to a first item that belongs in a group (appealed
claim 7) as discussed at column 8, lines 19-55 of Markman
satisfies all of the claimed requirements.

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of claim 27 which is directed to the feature of utilizing permanent labels on articles to determine the association with members of a group. We find no specific definition in

Appellant's specification of the term "permanent" that would distinguish over the permanence of labels attached to items, for example, by the heat sealing process discussed at column 7, line 31 of Markman. We also note that Markman, at column 11, lines 43-46, discusses the examination and association of permanent labels on articles with members of a particular group of articles.

Lastly, we also sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 28-33 based on the combination of Markman and Amacher. With respect to Appellant's arguments in response, it is our view that the arguments unpersuasively focus on the individual differences between the limitations of claims 28-33 and the Markman and Amacher references. It is apparent, however, from the Examiner's line of reasoning in the Answer, that the basis for the obviousness rejection is the combination of Markman and Amacher. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881(CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 1096, 231 USPQ 375, 380 (Fed. Cir. 1986).

In other words, while Appellant contends (Brief, pages 12 and 13) that Amacher lacks a teaching of a verification process,

it is our view that such "verification" feature is taught by

Markman for all of the reasons discussed <u>supra</u>. Similarly, while

Appellant contends that Markman lacks a teaching of indicating

when a scanning process starts successfully, ends successfully,

or ends unsuccessfully, this teaching is clearly provided by

Amacher.

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-4, 6-16, and 18-36 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR \$ 1.136(a).

## **AFFIRMED**

JERRY SMITH
Administrative Patent Judge

Joseph F. Ruggiero

Administrative Patent Judge

Administrative Patent Judge

ALLEN R. MACDONALD
Administrative Patent Judge

JFR/dal

FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON MA 02110 exp: one (as chlorophyll or on and usu, exhibiting bio-

reticus, fr. Gk porphyritikos, of or relating to porphyry in a relatively fine-grained

96): a more or less schis

the retinal rods of freshwa.

furie, fr. ML porphyrium, thos), lit., stone like Tyrian rock consisting of feldspar or purple groundmass

porpois, fr. ML porcopiscit ROW, FISH] (14c) 1: any of genus Phocaena); esp: a phocaena) of the north At-res) long 2: any of several

of porrigere to stretch out, at PORTEND, RIGHT] (15c)

/ (ca. 1643) : a soft food milk or water until thick otinger, ir. AF potageer, fr. 1522): a low metal bowl

F. fr. L portus -- more at ay ride secure from storm e ships may take on or dis

urta passage, gate; akin to L seat, or valve face b: the seat of valve face b: the seway for the working flud a place of access to a sys-Imit light or air or to load

4: a hole in an armored may be fired ortare] (14c) 1: the man-tate 3 3: the position in imand port arms
ie left — used chiefly as a

e left side of a ship or air-

ortified wine of rich taste wine made elsewhere

AF, fr. LL portabilis, fr. L
capable of being carried or : BEARABLE — ports bld ort-a-ble, 'port-\ adv

a [ME, fr. MF, fr. porter hy, insporting 2 archaic: the trying of boats or good; or around an obstacle that

or around an obstacle last the atransfer taged; por-tag-ing w (1860). The cover a portage of the city gate, portage in the city gate in the city gate.

body liver, fr. L. gate] (1845): the underside of the life lating to. or being a port

m of veins that begins

to the time spent by allects blood from one

through capillands and spleen to the live d -men-ti \-(.)te\ [It, iii]

<u>[:</u>

**Best Available Copy** 

(14c): a grating of iron hung over the gateway of a fortified place and lowered between grooves to prevent passage port de bras \pord-3-'bra\n [F. lit., carriage of the arm] (1912): the rechnique and practice of arm movement in ballet grating and practice of arm movement in ballet salut. Fr. Port du Salut. Trappist abbey in northwest France] (1881): a galut. fr. Port du Salut. Trappist abbey in northwest France] (1881): a pist nonks in France — called also Port Salut. Porte. [1881]: a pist nonks in France — called also Port Salut. Porte. [1881]: a pist nonks in France—called also Port Salut. Porte. [1881]: a pertent \pooling pooling pooli

picate. SiGNIFY portent ('pō(a)r-, ient, 'pō(a)r-, 'pō(a)r-,

of portendere] (ca. 1563) 1: something that foreshadows a coming event: ONEN 2: prophetic indication or significance 3: MARVEL. PRODICTY of the constituting a portent 2: eliciting amazement or wonder: PRODICTY of the constituting a portent 2: eliciting amazement or wonder: PRODICTY of the constituting a portent 2: eliciting amazement or wonder: PRODICTY of the constituting a portent 2: eliciting amazement or wonder: PRODICTY of the constitution and the constitution constitution and the c

9) rence
8) rence
8)

OF, lem. of portier porter, doorkeeper] (1843): a curtain management of portier porter, doorkeeper] (1843): a curtain management of portion portion portion akin to L portion \( \) \( \) portion \( \) \( \) portion \( \) portio

prition w por-tioned; por-tion-ing \-sh(s-)nij\ (14c) 1: to divide the pritions; DISTRIBUTE 2: to allot a dowry to: DOWER distribute 1: to allot a dowry to: DOWER distribute 2: to allot a dowry to: DOWER distribute 2: to allot a dowry to: DOWER distribute 3: allot a dowry or inheritance distribute 3: allot a dowry or inheritance down or inheritance down or inheritance down distribute 3: allot a distribute 3: allot

por-tress \'por-tress, 'por-\ n (15c): a female porter: as a: a door-keeper in a convent or apartment house b: CHARWOMAN
Port Roy-al-ist \port-'rois-lest, port-\ n [F port-royaliste, fr. Port-Royal, a convent near Versailles, France] (ca. 1727): a member or adherent of a 17th century French Jansenist lay community noted for its logicians

a 17th century French Jansenist lay community noteu for its logicians and educators
Port Salut \pōr-sal-'(y)ii. por-, -sal-\ n (1902): PORT DU SALUT
Portu-guese \pōr-cha-'gēz, por-, -gēs\ n. pl Portuguese [Pg portugués, adj. & n., fr. Portugal] (1615) 1: the Romance language of Portugal adj. & n., fr. Portugal (1615) 1: the Romance language of Portuguese descent — Portuguese adj. Portuguese dance—war n (1707): any of several large siphonophores (genus Physalia) having a large bladderlike sac or cyst with a broad crest on the upper side by means of which the colony floats at the surface of the sea por-tu-laca \pōr-cha-'lak-a, por-\ n [NL. fr. L. por-tu-laca \pōr-cha-'lak-a, por-tu-laca \pōr-cha-'lak-a, por-\ n [NL.

at the surface of the sea por-tu-leae \(\text{,por-ch-'lak-a}\), \(\phi\)or-\\ n \quad [NL \ fr. \ L. \\
purslane. \(\text{ In por-cha-'lak-a}\), \(\phi\)or \(\text{ of } n \quad [NL \ fr. \ L. \\
purslane. \(\text{ In por-cha-'lak-a}\), \(\text{ of porta gate:} \) \(\text{ fr. he lid} \)
of its capsule — more at PORT] (1548) : any of a genus \((Portulaca\)) of mainly tropical succulent herbs of the purslane family: esp: a plant \((P. gran-diffora\)) cultivated for its showy flowers
\(\text{po-sa-da}\) \(\text{ po-sa-da}\)\(\text{ po-sa-da}\)\(\text{ of posar to lodge. fr. LL \)
\(\text{ pausare}\)\(\text{ posar}\) (1763) : an inn in Spanish-speaking countries



herbs of the purslane family: esp: a plant (P. grond/pron) cultivated for its showy flowers passad hyps-Sad-yn [Sp. fr. posur to lodge. fr. LL posurer [1763]: an inn in Spanish-speaking poser, fr. (Sasumed) VL pausare. fr. LL. to stop. poser, fr. (Sasumed) VL pausare. fr. LL. to stop. rest. pause in L. pausa pause) w (14c) 1 a: to put or set for put or set for pause at 1 to put or set for the poser, fr. (Sasumed) VL pausare. fr. LL. to stop. rest. pause in the pause pause) w (14c) 1 a: to put or set for the poser of the stop of the passare. Fr. LL. to stop. rest. pause of the pause pause of the passare from the passare of the pa

position paper n (1949): a detailed report that recommends a course of action on a particular issue 'positive \particular issue 'positive \particular issue 'positive \particular issue 'positive \particular issue \particular issu

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or diminution b (1): independent of changing circumstances: Unconstruction (2): relating to or constituting a motion or device that is definite, unvielding, constant, or certain in its action (3 ~ system of levers) c (1): incontribution (2): unqualified (3) a = into fictions: Real, (a ~ influence for good in the community) b: active and effective in social or economic function rather than merely maintaining peace and order (a ~ generalized) a: having or expressing actual existence or runary generalized (a incomplete) (a pipelot) (2): capable of being constitution of light and shade similar in tone to the tone of the original subject (a ~ photographic mage) c: that is or is centraled in a direction arbitrarily or customarily taken as that of increase or progression (~ rotation of the earth) (we are making some ~ progress) d: directed or moving toward a source of stimulation (a ~ creas or progression (~ rotation of the earth) (we are making some ~ progress) d: directed or moving toward a source of stimulation (a ~ creating to the earth) (a progression (~ rotation of the earth) (a progression of the

also 'sesh-\ adj 'pos-ses-sive \po-'zes-iv also 'ses-\ adj (1530) 1: of, relating to, or constituting a word, a word group, or a grammatical case that denotes ownership or a relation analogous to ownership 2: manifesting possession or the desire to own or dominate — pos-ses-sive-ly adv — pos-

ses-sive-ness n Possessive n (1591) 1 a: the possessive case b: a word in the possessive case 2: a possessive word group

possessive adjective n (1870): a pronominal adjective expressing possessive adjective n (1870): a pronominal adjective expression possessive adjective n (1870): a pronominal adjective expression possessive adjective n (1870): a pronominal adjective n (1870): a pronominal adjective expression possessive adjective n (1870): a pronominal ad

possessive pronoun n (1530): a pronount hat derives from a personal pronoun and denotes possession and analogous relationships possessory \pa-'zes-(a-)re also -'ses-\ adj (1586) 1: of, arising from or having the nature of possession 2: having possession 3: characteristic of a possessor: PossesSive pos-set \pis-\pi -1 \ n [ME poshet. possol] (150: a hot drink of sweetened and spiced milk curdled with ale or wine possibility \pis-\pi -bil-\pi -1 \= \( n, pl \text{-ties} \) (1ec \) 1: the condition or fact of being possible 2: something that is possible 3 archaic: one's utmost power, capacity, or ability 4: potential or prospective value—usu. used in pl. (the house had great possibilities) possible \( \pi \) (pis-\pi -bil) \( adj \) (HE. fr. MF, fr. L possibilis, fr. posse to be able, fr. pois, pote able + esse to be — more at POTENT. [5] (14c) 1 a: being within the limits of ability, capacity, or realization b: being

what may be done or may occur according to nature, custom, or  $m_{din}$  ners 2 a: being something that may or may not occur b: hein something that may or may not be true or actual ( $\sim$  explanation): having an indicated potential (a  $\sim$  housing site) — possi-bly \ble odd.

syn possible. Practicable. Feasible mean capable of being realized Possible implies that a thing may certainly exist or occur given the proper conditions: PRACTICABLE implies that something may be easily or readily effected by available means or under current conditions. FEASIBLE applies to what is likely to work or be useful in attaining the end desired.

Sysum ('pais-pm\) n (1613): OPOSSIM

end desired.

pos-sum \pais-am\n (1613): opossum

pos-sum \pais-am\n (1613): opossum

pos-typost\pais (ME, fr. OE, fr. L postis; akin to Gk pro before and to Gi
histasthai to stand — more at FOR, STAND] (bef. 12c) 1: a piece (ac,
timber or metal) fixed firmly in an upright position esp. as a stay o
support: PILLAR, COLUMN 2: a pole or stake set up to mark or indi
cate something: esp: a pole that marks the starting or finishing pour
of a horse race 3: a metallic fitting attached to an electrical device (a
a storage battery) for convenience in making connections 4: 604

post

of a horse race 3: a metallic fitting attached to an electrical device to a storage battery) for convenience in making connections 4: total POST POST vr (1650) 1: to affix to a usual place (as a wall) for public notice: PLACARD 2 a: to publish, announce, or advertise by or as if by use of a placard b: to denounce by public notice: c: to enter on a publisiting d: to forbid (property) to trespassers under penality of lega prosecution by notices placed along the boundaries e: score post n [MF poste relay station, courier, fr. Olt posta relay station, flem, of posto, pp. of porre to place. fr. L ponere — more at rositios (1507) 1 obs: COURIER 2 archaic a: one of a series of stations be keeping horses for relays b: the distance between any two such consecutive stations: STAGE 3 chiefly Brit a: a nation's organization fix handling mail: also: the mail handled b: a single dispatch of mail c: POSTOPFICE d: POSTBON

\*\*POSTOPFICE d: POSTBON

post-mat-ing

post-me-di-eval post-mid-night post-mortal

ost-neo-na-tal

post-presidential

post-phic-bi-tic past-pal-li-ne-tio

post-pri-ma-ry

post-pris-on post-pu-ber-t) post-pu-ber-t) post-pu-ber-cst

post-race

post-abor-tion post-ac-ci-dent post-ad-o-les-cent nost-am-pu-ta-tion post-ar-rest post-atom-ic nost-at-tack post-au-dit post-bac-ca-lau-re-ate post-bach-e-lor nost-base post-bib-li-cal post bour geois post-burn post-cap-i-tal-ist post-chlo-ri-na-tion post-Chris-tian nost-civ-i-li-za-tion post-civ-i-lized post-co-ital post-col·lege nost-col·le-giate post-co-lo-nial post-con-cep-tion post-con-cert post-con-quest post-con-so-nan-tal post-con-ven-tion post-cop-u-la-to-ry ost-cor-o-nary post-cri-sis post-cri-sis post-crys-tal-li-za-tion post-Dar-win-ian post-dead-line post-de-bate post deb-u-tante ost-de-liv-erv post-de-po-si-tion-al post-de-pres-sion post-de-val-u-a-tion post-dive post-drug post-ed-it-ing

post-ed-u-ca-tion-al

post-elec-tion post-em-bry-o-nal post-em-bry-on-ic post-emer-genpost-en-ceph-a-lit-ic post-ep-i-lep-tic post-erup-tive post-ex-er-cise post-ex-pe-ri-ence post-ex-per-i-men-tal post-ex-plo-sion post-ex-po-sure post-fault post-flight post-frac-ture nost-freeze post-freeze post-game post-game post-gla-cial post-grad-u-a-tion post-hear-vest post-hear post-hem-or-rhag-ic post-hi-ber-na-tie post-hos-pi-tal post-hu-man post-im-pact post-im-pe-ri-al post-in-au-gu-ral post-in-cu-nab-u-la post-in-de-pen-dence post-in-dus-tri-al post-in-fec-tion post-in-jec-tion post-in-jec-tion post-in-oc-u-la-tion post-ir-ra-di-a-tion post-isch-emic post-iso-la-tion post-land-ing post lar val post-launch post-lib-er-a-tion post-lit-er-ate ost-mar-i-tal post-mas-tec-to-my